

## REMARKS

This application has been reviewed in light of the Office Action dated August 24, 2004. Claims 1, 58, and 60-66 are presented for examination, of which Claims 1, 58, 61, 62, 64, and 65 are in independent form. Claims 3, 4, 41, 54-57, and 59 have been canceled, without prejudice or disclaimer of subject matter. Claims 1, 58, and 60 have been amended to define more clearly what Applicants regard as their invention. Claims 61-66 have been added to provide Applicants with a more complete scope of protection. Favorable reconsideration is requested. The canceled claims will not be further addressed herein.

Claims 1, 58, and 60 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

These claims have been carefully reviewed and amended as deemed necessary to ensure that they conform fully to the requirements of Section 112, second paragraph, with special attention to the points raised in paragraph 5 of the Office Action. It is believed that the rejection under Section 112, second paragraph, has been obviated, and its withdrawal is therefore respectfully requested.

Claims 1, 58, and 60 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,992,940 (*Dworkin*), as well as being unpatentable over U.S. Patent No. 6,324,522 B2 (*Peterson et al.*) in view of U.S. Patent No. 6,463,437 (*Mongilio*).

As shown above, Applicants have amended independent Claims 1 and 58 in terms that more clearly define what they regard as their invention. Applicants submit that these amended independent claims and new independent Claims 61, 62, 64, and 65, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

The aspect of the present invention set forth in Claim 1 is a processing method of ordering a new consumable to be used by a printer and returning a used consumable, used by the printer, being performed by an information processing system capable of communicating with a plurality of terminals via the Internet. The method includes receiving participating information, indicating whether or not a user wishes to participate in a return service, from at least one terminal of the plurality of terminals, where the return service is provided by the system allowing the user to return the used consumable, and setting a flag in a memory unit managed by the information processing system, in accordance with the participating information. The method also includes transmitting first information containing data fields to at least one of the plurality of terminals for display on a screen, and allowing the user to input data into the data fields to order the new consumable and specify the return of the used consumable, and transmitting second information for display on the screen of at least one of the plurality of terminals, which includes a message (a) to prompt the user concerning the return service in a case when the flag set in the setting step indicates that user did not wish to participate in the return service, and (b) indicating a history regarding the return of the used consumable by the user and an incentive point corresponding to the history in a case when the flag set in the setting step indicates that the user wished to participate in the return service.

The object of the present invention is to promote the return consumables, improve the recycling of parts of the returned consumables, and to protect the environment by reducing the amount of waste buildup of consumables. To achieve these objects, a return service is provided to efficiently collect used consumables by managing the history regarding the used consumable returned by the user and providing an incentive point to the user according to the history, when the user wishes to participate in the return service.

Among other notable features of Claim 1 are receiving participating information, indicating whether or not a user wishes to participate in a return service, from at least one terminal of the plurality of terminals, where the return service is provided by the system allowing the user to return the used consumable, and transmitting second information for display on the screen of at least one of the plurality of terminals, which includes a message (a) to prompt the user concerning the return service in a case when the flag set in the setting step indicates that user did not wish to participate in the return service, and (b) indicating a history regarding the return of the used consumable by the user and an incentive point corresponding to the history in a case when the flag set in the setting step indicates that the user wished to participate in the return service.

*Dworkin* relates to an automated system and method for locating and purchasing products or services having desired characteristics. The Examiner appears to take the position that the data does not functionally relate to the steps in the method, and that the content of *Dworkin* can be substituted with any type of content. Applicants respectfully disagree.

The flag set in the setting step is set in accordance with the received participating information. Also, the content of the message included in the transmitted second information, (a) to prompt the user concerning the return service in a case when the flag set in the setting step indicates that user did not wish to participate in the return service, and (b) indicating a history regarding the return of the used consumable by the user and an incentive point corresponding to the history in a case when the flag set in the setting step indicates that the user wished to participate in the return service, is clearly dependent upon the flag being set in the setting step in accordance with the participating information.

Further, according to the Examiner, the flag set in the *Dworkin* system is merely a simple check to see if the information was input into the system properly. However, the flag set in Claim 1 is set in accordance with the participating information, not whether the information was properly input.

Still further, nothing has been found in *Dworkin* that would teach or suggest receiving participating information, indicating whether or not a user wishes to participate in a return service, from at least one terminal of the plurality of terminals, where the return service is provided by the system allowing the user to return the used consumable, and transmitting second information for display on the screen of at least one of the plurality of terminals, which includes a message (a) to prompt the user concerning the return service in a case when the flag set in the setting step indicates that user did not wish to participate in the return service, and (b) indicating a history regarding the return of the used consumable by the user and an incentive point corresponding to the history in a case when the flag set in the setting step indicates that the user wished to participate in the return service, as recited in Claim 1.

For at least the above reasons, Applicants submit that Claim 1 is clearly patentable over *Dworkin*.

*Peterson et al.* relates to distribution networks for distributing parts from a manufacturer, through vendors, to end-users.

The Office Action correctly states, at page 5, that *Peterson et al.* does not disclose returning goods.

For at least this reason, Applicants submit that Claim 58 is clearly patentable over *Peterson et al.*, taken alone.

The Office Action cites *Mongilio* as remedying the deficiencies of *Peterson et al.*, and in particular disclosing the return of goods using the Internet. Applicants understand

*Mongilio* as merely discussing returning a sample of the products (column 6, lines 4 and 5).

However, the good returned in *Mongilio* is not used goods as recited in Claim 1.

Further, nothing has been found in *Peterson et al.* and *Mongilio* that would teach or suggest receiving participating information, indicating whether or not a user wishes to participate in a return service, from at least one terminal of the plurality of terminals, where the return service is provided by the system allowing the user to return the used consumable, and transmitting second information for display on the screen of at least one of the plurality of terminals, which includes a message (a) to prompt the user concerning the return service in a case when the flag set in the setting step indicates that user did not wish to participate in the return service, and (b) indicating a history regarding the return of the used consumable by the user and an incentive point corresponding to the history in a case when the flag set in the setting step indicates that the user wished to participate in the return service, as recited in Claim 1.

Therefore, even if *Peterson et al.* and *Mongilio* were to be combined in the manner proposed in the Office Action, assuming such combination would even be permissible, the resulting combination also would fail to teach or suggest at least the features of Claim 1.

Independent Claims 61 and 64 are computer readable storage medium and apparatus claims respectively corresponding to method Claim 1, and are believed to be patentable over cited prior art for at least the same reasons as discussed above in connection with Claim 1.

The aspect of the present invention set forth in Claim 58 is a processing method of returning a used consumable, used by a printer, being performed by an information processing system capable of communicating with a plurality of terminals via the Internet.

The method includes receiving user log-in information from one of the plurality of terminals, reading a history regarding the used consumable returned by a user corresponding to the user log-in information, from a database, and determining an incentive point based on the history read in the reading step. The method also includes generating a message indicating the history read in the reading step and the incentive point determined in the determining step, to be sent to one of the plurality of terminals.

Among other notable features of Claim 58 are determining an incentive point based on the history read in the reading step, corresponding to the user log-in information, and generating a message indicating the history read in the reading step and the incentive point determined in the determining step, to be sent to one of the plurality of terminals.

The Office Action provided no grounds for rejecting Claim 58. The only grounds specified in the Office Action concerns the features of Claim 1. Applicants wish to point out that Claim 58 recites, among other things, receiving user log-in information from a terminal. Nothing has been found, or pointed out, in *Dworkin*, *Peterson et al.* or *Mongilio* that would teach or suggest receiving user log-in information from a terminal, much less determining an incentive point based on the history read in the reading step, corresponding to the user log-in information, as recited in Claim 58.

Further, nothing has been found in *Dworkin*, *Peterson et al.* or *Mongilio* that would teach or suggest generating a message indicating the history read in the reading step and the incentive point determined in the determining step, to be sent to one of the plurality of terminals, as recited in Claim 58.

For at least the above reasons, Applicants submit that Claim 58 is clearly patentable over *Dworkin*. Further, even if even if *Peterson et al.* and *Mongilio* were to be combined in the manner proposed in the Office Action, assuming such combination would

even be permissible, the resulting combination also would fail to teach or suggest at least the features of Claim 58. Accordingly, Applicants submit that Claim 58 is clearly patentable over the cited prior art.

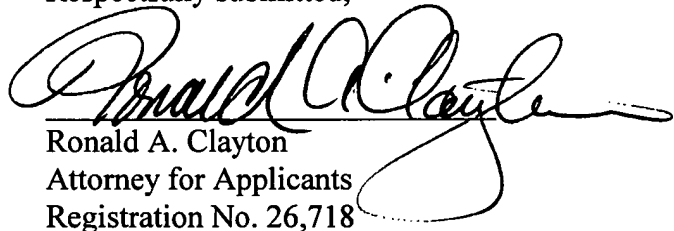
Independent Claims 62 and 65 are computer readable storage medium and apparatus claims respectively corresponding to method Claim 58, and are believed to be patentable over cited prior art for at least the same reasons as discussed above in connection with Claim 58.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

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